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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,248	11/30/2001	Purushothama Rao	214723	5682

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EXAMINER

ALEJANDRO, RAYMOND

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 05/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,248

Applicant(s)

RAO, PURUSHOTHAMA

Examiner

Raymond Alejandro

Art Unit

1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005 and 01 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/14/05 and 04/01/05 has been entered.

This office action is being provided in reply to the amendment accompanying the foregoing RCE. The applicant has overcome the objection, the double patenting rejections and the 35 USC 103 rejection. Refer to the foregoing amendments for more details on applicant's rebuttal arguments. However, the present claims are rejected again over the same art as set forth infra and for the reasons of record:

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujisawa et al 5342698.

As for claim 1:

Fujisawa et al disclose examples of metal crystals having a face-centered cubic structure are alloys crystals such as Pb (COL 4, lines 58-63). In particular, Fujisawa et al disclose a Pb

Art Unit: 1745

based alloy containing Sn as a requisite alloy element and if necessary, may contain Ag and Ca (COL 7, lines 52-62). It is disclosed that if the crystal face is oriented in the direction perpendicular to the (h00) plane in this manner, the atomic density in the direction of the orientation becomes high because the crystal structure of the Pb alloy is face-centered cubic structure. Therefore, the alloy material has an increased hardness to exhibit enhanced seizure and wear resistance (COL 14, lines 52-59). It is further disclosed that from the respect that the first oriented crystal a face-centered cubic structure due to the orientation of the (h00) plane, the atomic density is increased in the direction of the orientation, so that the surface material (the alloy per se) has an increased hardness, thereby assuring an enhanced wear resistance of the alloy material (COL 8, lines 44-52).

Examiner's note: as to the specific preamble reciting "a grid for use in a lead-acid battery", it is pointed out that the preamble refers to intended use. That is, the claim is directed to a "grid" per se and the preamble phrase "for use in a lead-acid battery" is only a statement of ultimate intended utility.

As to claim 2:

As to the method limitation, *i.e. the alloy strip been heat-aged at certain temperature*, it is noted that a method limitation incorporated into a product claim does not patentable distinguish the product because what is given patentably consideration is the product itself and not the manner in which the product was made. Therefore, the patentability of a product is independent of how it was made.

Consequently, the claims are anticipated by the prior art.

Art Unit: 1745

Response to Arguments

4. Applicant's arguments with respect to claims 1-2 have been considered but are moot in view of the new ground(s) of rejection.

5. Although believed unnecessary due to the new grounds of rejection, the examiner likes to briefly address certain applicant's arguments.

6. In response to applicant's arguments that "*the problems faced by the designer of a part for use in an engine and the designer of a grid for use in storage battery typically filled with concentrated sulfuric acid are quite different (e.g. Fujisawa teaching a metallurgy being directed toward mechanical wear and its associated properties while the grid for use in a lead-acid battery is primarily subjected to wear from chemical degradation, temperature changes and similar non-mechanical stress)*", it is noted that arguments that the alleged anticipatory prior art is nonanalogous art or teaches away from the invention or is not recognized as solving the problem solved by the claimed invention, [are] not germane to a rejection under section 102. *Twin Disc, Inc. v. United States*, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting *In re Self*, 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982)). See also *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1068, 68 USPQ2d 1481, 1488 (Fed. Cir. 2003) (***See MPEP 2131.05 [R-2] Nonanalogous Art***).

Moreover, it is noted that Fujisawa's metallurgical feature must also exhibit the same properties argued by the applicant because products of identical chemical composition can not have mutually exclusive properties, and thus, the argued claimed property is necessarily present in the prior art material.

Art Unit: 1745

7. In response to applicant's argument that "*nowhere does Fujisawa suggest their (metal structure having a face-centered cubic structure) use in grids for lead-acid storage batteries*", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

8. In response to applicant's argument that "*Fujisawa fails to teach the metal structurewould have increased corrosion resistance*", the fact that applicant has recognized another advantage/disadvantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be anticipated/obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond Alejandro whose telephone number is (571) 272-1282. The examiner can normally be reached on Monday-Thursday (8:00 am - 6:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1745

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Raymond Alejandro
Primary Examiner
Art Unit 1745



RAYMOND ALEJANDRO
PRIMARY EXAMINER